

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: April 20, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*Nike, Inc.*

*v.*

*Honest E Online LLC*

Opposition No. 91254139

Helen Hill Minsker of Arnold & Porter Kaye Scholer LLP,  
for Nike, Inc.

John E. Sweeney of John Sweeney & Associates,  
for Honest E Online LLC.

Before Bergsman, Adlin, and Lebow,  
Administrative Trademark Judges.

Opinion by Lebow, Administrative Trademark Judge:

Honest E Online LLC (“Honest E”) seeks registration on the Principal Register of the standard character mark JUST BET IT for “wearable garments and clothing, namely, shirts” in International Class 3 (“the Application”).<sup>1</sup>

<sup>1</sup> Application Serial No. 88584643 was filed on August 19, 2019, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Honest E’s allegation of a bona fide intention to use the mark in commerce.

Nike, Inc. (“Nike”) opposed registration of Honest E’s mark on the grounds of likelihood of confusion and dilution. 15 U.S.C. §§ 1052(d), 1125(c).<sup>2</sup> Nike claims ownership of the six registrations of the mark JUST DO IT in standard characters or in typed format<sup>3</sup> for various goods and services, including “clothing, namely t-shirts, sweatshirts and caps,”<sup>4</sup> “tank tops,”<sup>5</sup> and other clothing items in International Class 25.<sup>6</sup> Nike also claims prior common law rights in the mark in connection with “various clothing goods” in commerce since as early as 1989.<sup>7</sup>

Honest E, in its amended answer, admitted that: (1) Nike is the owner of its pleaded registrations; (2) Nike has continuously used the JUST DO IT mark in interstate commerce since at least as early as 1989 in connection with various clothing items; (3) Nike’s use and registration of its JUST DO IT Mark is long prior to the filing date of the Application; (4) Honest E was aware of Nike’s JUST DO IT Mark when it filed the Application; and (5) the goods identified in the Application are identical or related to Nike’s goods and services for the JUST DO IT Mark.”<sup>8</sup> Honest E denied the remaining salient allegations in the notice of opposition.

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<sup>2</sup> 1 TTABVue (Notice of Opposition).

<sup>3</sup> Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. A typed or typeset mark is the legal equivalent of a standard character mark. *See In re Vittera, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2. (Fed. Cir. 2012).

<sup>4</sup> Registration No. 1875307, registered January 24, 1995; renewed.

<sup>5</sup> Registration No. 4764071, registered June 30, 2015.

<sup>6</sup> The other pleaded registrations are Registration Nos. 4350316, registered June 11, 2013; Section 8 accepted; 4704671, registered March 17, 2015; 4764071, registered June 30, 2015; 4902036, registered February 16, 2016; and 5727940, registered April 16, 2019; for goods and services in International Classes 8, 25, and 35.

<sup>7</sup> *Id.* at 6.

<sup>8</sup> 7 TTABVue.

## **I. Accelerated Case Resolution (“ACR”)**

The parties stipulated to Accelerated Case Resolution (“ACR”), an expedited means of resolving inter partes cases. *See generally* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) §§ 528.05(a)(2), 702.04 (2020).<sup>9</sup> The Board noted and approved the parties’ ACR stipulation, under which the Board may resolve and decide any genuine dispute of material fact it may find to exist based on the record, and render a final decision based on the record and briefs.<sup>10</sup>

## **II. The Record**

Honest E did not file a brief or evidence. The record consists of the pleadings; the file of the Application pursuant to Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1); status and title printouts of Nike’s pleaded registrations from the USPTO’s Trademark Status and Document Retrieval (TSDR) database filed with the notice of opposition;<sup>11</sup> and the following testimony and evidence submitted by Nike:

- Notice of reliance on articles from newspapers and periodicals referencing Nike and its JUST DO IT mark, and advertisements featuring the JUST DO IT mark;<sup>12</sup>
- Declaration of Jennifer M. Reynolds (“Reynolds Decl.”), an assistant general counsel at Nike, relating to Nike’s trademark rights in, sale of products bearing, use of, third-party recognition of, and enforcement of, Nike’s JUST DO IT mark, as well as Honest E’s attempt to register the JUST BET IT mark; and exhibits;<sup>13</sup>

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<sup>9</sup> 12 TTABVUE (ACR Stipulation). The parties agreed, inter alia, that documents “may be submitted ... in the form of notices of reliance,” or “may be submitted as exhibits to the parties’ ACR briefs.” *Id.* at 3.

<sup>10</sup> 13 TTABVUE (Order).

<sup>11</sup> 1 TTABVUE 12-46 (Notice of Opposition, Exhibit A).

<sup>12</sup> 20-21 TTABVUE.

<sup>13</sup> 22 TTABVUE.

- Declaration of Melanie Sedler (“Sedler Decl.”), a senior paralegal for Nike, relating to the history of, advertisements and promotions pertaining to, and products sold in connection with, Nike’s JUST DO IT mark; and exhibits;<sup>14</sup> and
- Declaration of Timothy J. Haugh (“Haugh Decl.”), a case manager at the law firm of Nike’s counsel, relating to Nike’s use of the JUST DO IT mark at in-store displays and in connection with products and services, its digital and social media presence, and awards and recognition of the mark; and exhibits.<sup>15</sup>

### III. Entitlement to a Statutory Cause of Action<sup>16</sup>

Entitlement to a statutory cause of action must be proven in every inter partes case. *See Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at \*3 (Fed. Cir. 2020) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067 n.4 (2014)). A party in the position of plaintiff may oppose registration of a mark when it demonstrates an interest falling within the zone of interests protected by the statute, 15 U.S.C. § 1063, and the party has a reasonable belief in damage that is proximately caused by continued registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, \*6-7 (Fed. Cir. 2020).

Because Nike properly introduced into evidence copies of its pleaded registrations

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<sup>14</sup> 23 TTABVUE.

<sup>15</sup> 24-25 TTABVUE.

<sup>16</sup> Board decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of “standing.” Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Section 13 and 14 remain applicable. *See Spanishtown Enters., Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, at \*2 (TTAB 2020).

showing their current status as valid and title in Nike,<sup>17</sup> and Honest E has admitted to Nike's ownership of those registrations,<sup>18</sup> Nike has established its entitlement to a statutory cause of action. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1032 (TTAB 2016) (entitlement established based on pleaded registration made of record).

#### **IV. Likelihood of Confusion**

“The Lanham Act provides national protection of trademarks in order to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers.” *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 105 S. Ct. 658, 83 L. Ed. 2d 582, 224 USPQ 327, 331 (1985). Consistent with these purposes, Section 2(d) of the Lanham Act prohibits registration of a mark that “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office ... as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d).

##### **A. Priority Not At Issue**

Because Nike's pleaded registrations are of record and Honest E has not counterclaimed to cancel them, priority is not at issue respect to the marks and goods and services identified in those registrations. *Mini Melts, Inc. v. Reckitt Benckiser*

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<sup>17</sup> 1 TTABVUE 12-46 (Notice of Opposition, Exhibit A).

<sup>18</sup> 7 TTABVUE (Amended Answer).

*LLC*, 118 USPQ2d 1464, 1469 (TTAB 2016) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)).

Additionally, Nike provided testimony that it has continuously sold products, including footwear and various types of apparel, including t-shirts, sweatshirts, and polo shirts since 1989.<sup>19</sup> With reference to the sales of shoes in particular, “between 2006 and 2010, NIKE distributed approximately 900 million shoe boxes displaying JUST DO IT. Since then, NIKE has distributed over 1.5 billion shoe boxes displaying JUST DO IT,” such as the image shown below. Accordingly, Nike has also demonstrated common law priority with respect to footwear as well.



### **B. The *DuPont* Factors**

We base our determination of likelihood of confusion under Section 2(d) on an analysis of all of the probative facts of record. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). In assessing likelihood of confusion, we consider each *DuPont* factor for which there is evidence and argument. *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1161-62 (Fed. Cir. 2019). “Not all of the DuPont factors are relevant to every case, and only factors

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<sup>19</sup> 23 TTABVUE 21 (Sedler Decl., ¶ 39).

of significance to the particular mark need be considered.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (Fed. Cir. 2018), *cert. denied*, 139 S. Ct. 1550 (2019) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)).

Moreover, we may assign varying weights to each *DuPont* factor depending on the evidence presented in a particular case. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“the various evidentiary factors may play more or less weighty roles in any particular determination”). “In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services.” *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945 (Fed. Cir. 2004), cited in *Ricardo Media v. Inventive Software*, 2019 USPQ2d 311355 at \*5.

In this case, we will focus our analysis on Nike’s pleaded Registration Nos. 1875307 (JUST DO IT.) for clothing, namely t-shirts, sweatshirts and caps, and 4764071 (JUST DO IT) for, inter alia, footwear, headbands, headwear, pants, shorts, sports bras, tank tops, tights, and warm up suits (collectively, the “Apparel Registrations”), which are most similar to the Application, which identifies “wearable garments and clothing, namely, shirts.” If we do not find confusion likely between the marks in the Apparel Registrations and Honest E’s mark, we would also not find confusion likely between the marks in Nike’s other claimed registrations and the

mark in the Application. *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

### **1. The Fame of Nike's JUST DO IT Mark**

We begin with the alleged fame of Nike's JUST DO IT mark. Under this fifth *DuPont* factor, we consider the fame or strength of an opposer's mark in order to evaluate the scope of protection to which it is entitled. Fame, when present, plays a dominant role in a likelihood of confusion analysis because of the broad scope of protection afforded famous or strong marks. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002), Famous marks "enjoy a wide latitude of legal protection." *Id.* (quoting *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000)). A strong mark "casts a long shadow which competitors must avoid." *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame for likelihood of confusion purposes arises "as long as a significant portion of the relevant consuming public ... recognizes the mark as a source indicator," *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1694, and "may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident." *Bose*, 63 USPQ2d at 1305. While consumer surveys may provide direct evidence of fame, they are not necessary; indeed, they "rarely appear." *Id.* Other relevant factors include the "length of use of the mark, market share, brand awareness, licensing activities, and variety of goods bearing the mark." *Coach Servs., Inc. v. Triumph*



*Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012).

“Fame for likelihood of confusion and fame for dilution are distinct concepts, and dilution fame requires a more stringent showing. ... Accordingly, a mark can acquire ‘sufficient public recognition and renown for purposes of likelihood of confusion without meeting the more stringent requirement for dilution fame.” *Coach Servs.*, 101 USPQ2d at 1724. Nike points out that the Board has previously found Nike’s JUST DO IT mark famous—under the more stringent dilution standard—“five times in the last decade,” including in *Nike, Inc. v. Maher*, 100 USPQ2d 1018 (TTAB 2011); *Nike, Inc. v. Capital E Finance Co., LLC*, Opposition No. 91221511 (TTAB June 24, 2016, non-precedential); *Nike, Inc. v. Bauman-Buffone*, Opposition No. 91234556 (TTAB March 20, 2019, non-precedential); *Nike, Inc. v. Caldwell*, Opposition No. 91240394, Opposition No. 91240394, (TTAB April 28, 2010, non-precedential); and *Nike, Inc. v. Muntean*, Opposition No. 91247956 (TTAB Sept. 10, 2020, non-precedential).

Nevertheless, fame is a factual matter that Nike must establish on the record in each proceeding. “[I]t is well settled that a decision in a prior case is incompetent as proof of any fact recited therein as against one who was not a party thereto.” *Chicken Delight, Inc. v. Delight Wholesale Co.*, 193 USPQ 175, 177 (TTAB 1976), citing *Aloe Creme Labs., Inc. v. Bonne Bell, Inc.*, 168 USPQ 246 (TTAB, 1970). Notwithstanding, as detailed below, Nike’s evidence of fame is considerable.

**a. Volume of Sales for JUST DO IT Goods**

Jennifer Reynolds, an assistant general counsel with Nike, testified that “Nike conservatively calculates that it has sold approximately 100 million units of products

bearing JUST DO IT ... in ... the United States from 1989 to the present, totaling over \$1 billion in net sales.”<sup>20</sup> She provided a breakdown of the quantity of units sold by Nike and its net sales for each year from 1989 through 2019 showing an upward trend.<sup>21</sup> According to that breakdown,<sup>22</sup> Nike’s sales of products bearing JUST DO IT between 2015 and 2019, which included “many different types of apparel, such as t-shirts, sweatshirts, tank tops, polo shirts, and jackets, as well as footwear, bumper stickers, keychains, water bottles, lanyards, wristbands, backpacks, duffle bags, sunglasses, and cell phone covers, among other things,”<sup>23</sup> have exceeded 60 million units.<sup>24</sup>

**b. Advertising Expenditures for JUST DO IT Goods**

Melanie Sedler, a senior paralegal with Nike, testified that “Nike is the largest seller of athletic footwear and apparel in the world,”<sup>25</sup> and Ms. Reynolds further testified that Nike “estimates that, in the United States alone, it has spent over \$200 million on advertisements and promotions featuring JUST DO IT since 2008.”<sup>26</sup>

Nike’s advertisements “have featured numerous world-class athletes over the past thirty years, including Olympian, Carl Lewis; professional baseball and football player, Bo Jackson; professional basketball player, Michael Jordan; professional

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<sup>20</sup> 22 TTABVUE 4-5 (Reynolds Decl., ¶ 10).

<sup>21</sup> *Id.* at 19 (Exhibit B-1).

<sup>22</sup> *Id.*

<sup>23</sup> 23 TTABVUE 21 (Sedler Decl., ¶ 39).

<sup>24</sup> 22 TTABVUE 5 (Reynolds Decl., ¶ 10).

<sup>25</sup> 23 TTABVUE 4 (Sedler Decl., ¶ 6).

<sup>26</sup> 22 TTABVUE 5 (Reynolds Decl., ¶ 10).

football player, Howie Long; professional tennis player, Pete Sampras; professional basketball player, Charles Barkley; professional golfer, Tiger Woods; professional basketball player, LeBron James; professional tennis player, Serena Williams; Olympian, Simone Biles; and professional football player Colin Kaepernick, among many others.”<sup>27</sup>

For example, “NIKE aired a commercial during the 2008 Olympics . . . prominently featuring the JUST DO IT mark,” and YouTube video views of that commercial “exceeded one million.”<sup>28</sup>

In 2018, Nike celebrated the 30<sup>th</sup> Anniversary of its JUST DO IT mark with its “Dream Crazy” advertising campaign in New York City and Los Angeles featuring celebrities promoting the JUST DO IT MARK, as seen in the following examples promoting the mark via celebrity athletes LeBron James and Serena Williams:<sup>29</sup>

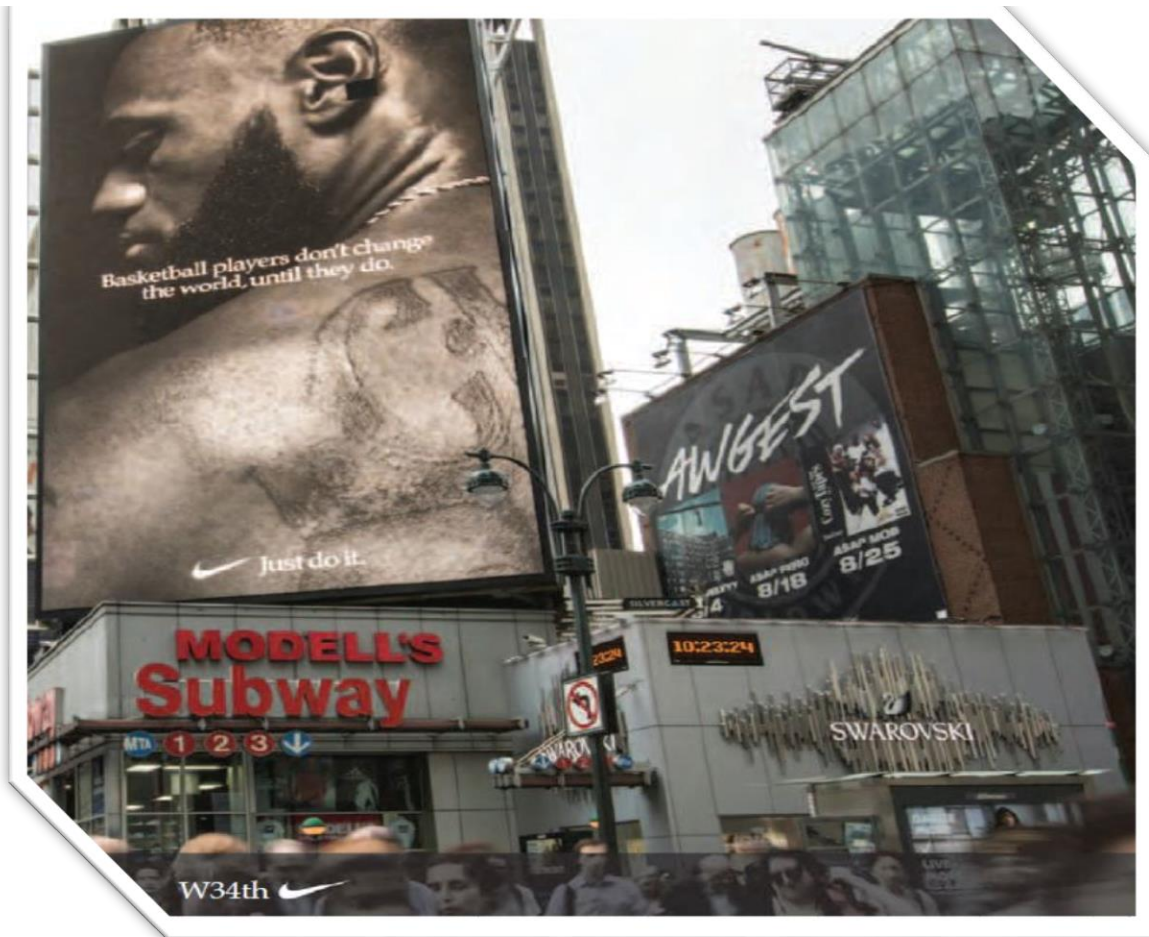


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<sup>27</sup> 23 TTABVUE 8 (Sedler Decl., ¶ 19).

<sup>28</sup> *Id.*

<sup>29</sup> *Id.* at 85, 89-91 (Exhibit C-17).





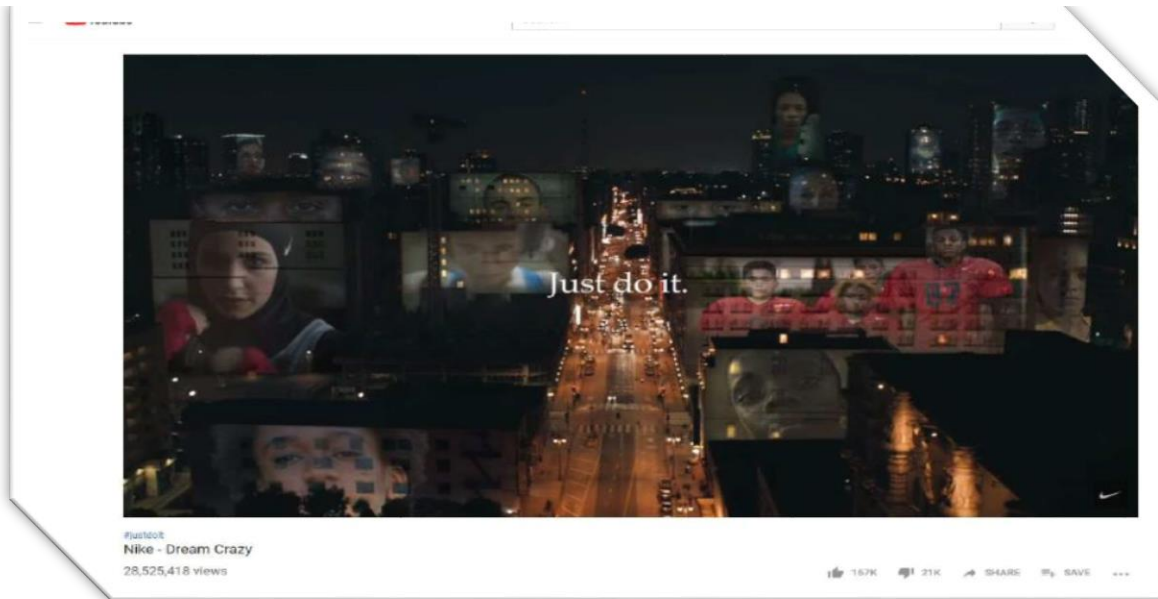


One of the commercials released in connection with the JUST DO IT Dream Crazy campaign, which featured former NFL football player Colin Kaepernick, “received an Emmy Award in 2019 for ‘Outstanding Commercial,’” and the uploaded YouTube video of the commercial “received over 28 million views in seven months”:<sup>30</sup>



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<sup>30</sup> *Id.* at 15-16 (¶¶ 29-30), and the video, Exhibit C-16, was provided as a bulky exhibit.



**c. Widespread Recognition of the JUST DO IT Mark in Media**

Ms. Reynolds testified that “[b]ecause of the notoriety of the JUST DO IT trademark, it has received a substantial recognition over the years from third parties,” many of which “have recognized the JUST DO IT trademark as strong, distinctive, and even famous.”<sup>31</sup> Nike provided close to 100 such examples, such as the following:<sup>32</sup>

- A 1990 USA TODAY article noting that “[Nike’s] ‘Just Do it’ advertising slogan is one of those rare gems that have transcended advertising to enter popular culture and language.”<sup>33</sup>
- A circa 1999 Center for Applied Research case study on Nike’s JUST DO IT MARK that describes JUST DO IT as “one of the most famous and easily recognized slogans in advertising history,” and states that “‘Just Do It’ succeeded in that it convinced Americans that wearing Nikes for every part of your life was smart (the shoes are designed for comfort)

<sup>31</sup> 22 TTABVUE 7 (Reynolds Decl., ¶ 17).

<sup>32</sup> While such documents are not admissible for the truth of the matter contained therein, they are probative of what the authors and readers perceive.

<sup>33</sup> 20 TTABVUE 47-49 (Nike’s NOR, Exhibit A-16).

and hip (everyone else is wearing them, you too can belong to this group).”<sup>34</sup>

- A 1999 Ad Age (adage.com) article lists JUST DO IT as number two out of “the top 10 slogans for the 20<sup>th</sup> Century.”<sup>35</sup>
- A 2008 article from The Oregonian newspaper reported that Nike’s JUST DO IT “eight-letter phrase is among the two or three slogans rated most memorable in advertising history,” and that “people wrote to Nike saying ‘Just Do It’ had inspired them to leave abusive husbands and achieve heroic feats.”<sup>36</sup>
- A 2010 Business Line article, in a piece unrelated to Nike, ends the article with the statement, “As the famous Nike ad says, ‘just do it.’”<sup>37</sup>
- A 2015 Branding Strategies Insider (brandingstrategiesinsider.com) article states that “[p]rior to the launch of Just Do It, Nike brand sales, which had been struggling, “were rejuvenated, increasing 1,000% over the next ten years.”<sup>38</sup>
- A 2018 Chicago Business Journal article about Nike’s presence at an upcoming Chicago marathon describes JUST DO IT as “one of the most iconic and instantly recognizable taglines in all of advertising.”<sup>39</sup>

#### **d. Conclusion as to Fame**

The evidence in this case establishes that Nike has used the JUST DO IT mark intensively for more than 30 years on and in connection with a variety of goods, including clothing and shoes, and Nike’s advertising efforts (amounting to approximately \$200 million since 1989)<sup>40</sup> and sales of its goods provided under the

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<sup>34</sup> 22 TTABVUE 7 (Reynolds Decl., ¶ 19), 20-23 (Exhibit B-2).

<sup>35</sup> 24 TTABVUE 339-343 (Haugh Decl, Exhibit D-15).

<sup>36</sup> 21 TTABVUE 102-105 (Nike’s NOR, Exhibit A-78).

<sup>37</sup> 21 TTABVUE 125-127 (Nike’s NOR, Exhibit A-84).

<sup>38</sup> *Id.* at 164-169 (Exhibit A-92).

<sup>39</sup> *Id.* at 179-181 (Exhibit A-96).

<sup>40</sup> 23 TTABVUE 21 (Sedler Decl., ¶ 44).

mark (totaling more than \$1 billion in sales, and now averaging close to \$200 million per year)<sup>41</sup> have been more than substantial. Coupled with widespread, extensive and unsolicited media coverage recognizing the JUST DO IT mark's fame and consumer awareness, it is undeniable that "a significant portion of the relevant consuming public recognizes the mark as a source indicator." *Palm Bay Imps.*, 73 USPQ2d at 1694.

"Likelihood of confusion fame 'varies along a spectrum from very strong to very weak.'" *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 1344 (Fed. Cir. 2003)). To say that Nike's JUST DO IT mark is "very strong" may be an understatement. Accordingly, we find that JUST DO IT is a very strong mark entitled to a very broad scope of protection. This factor weighs heavily in favor of finding likelihood of confusion.

## **2. Similarity or Dissimilarity of the Goods and Trade Channels**

The second *DuPont* factor considers the "similarity or dissimilarity and nature of the goods or services as described in an application or registration . . .," and the third *DuPont* factor considers the "similarity or dissimilarity of established, likely-to-continue trade channels." *DuPont*, 177 USPQ at 567. We make our determinations for these factors based on the goods as they are identified in the application and cited registrations. *See In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110

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<sup>41</sup> 22 TTABVue 19 (Reynolds Decl., Exhibit B-1).



USPQ2d 1157, 1161 (Fed. Cir. 2014).

The “t-shirts” and “tank tops” identified in Nike’s Apparel Registrations are encompassed by and therefore legally identical to the “shirts” in the Application, and Honest E concedes in its amended answer that the goods are “identical or related.”<sup>42</sup> *See In re Solid State Design Inc.*, 125 USPQ2d 1409, 1413-14 (TTAB 2018) (where the goods in an application or registration are broadly described, they are deemed to encompass all the goods of the nature and type described therein); *In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”).

Because the goods described in the application and Nike’s registrations are in part legally identical, we presume that the channels of trade and classes of purchasers are the same. *See In re Viterro Inc.*, 101 USPQ2d at 1908 (Fed. Cir. 2012) (identical goods are presumed to travel in same channels of trade to same class of purchasers) (cited in *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (“With respect to similarity of the established trade channels through which the goods reach customers, the TTAB properly followed our case law and ‘presume[d] that the identical goods move in the same channels of trade and are available to the same classes of customers for such goods....”); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *United*

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<sup>42</sup> 7 TTABVUE (Amended Answer).

*Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014).

The second and third *DuPont* factors also weigh heavily in favor of finding likelihood of confusion.

### **3. Similarity or Dissimilarity of JUST DO IT and JUST BET IT**

We now turn to the first *DuPont* factor, the “similarities or dissimilarities of the marks in their entirety as to appearance, sound, connotation and commercial impression.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 177). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, 777 Fed. Appx. 516 (Fed. Cir. 2019); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

The test is not whether consumers can distinguish the marks in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the goods and services offered under the respective marks is likely to result. *See Cai v. Diamond Hong*, 127 USPQ2d at 1801 (citing *Coach Servs*, 101 USPQ2d at 1721. In addition, “[b]ecause [Nike’s] mark is famous, it enjoys a wide latitude of protection, and the degree of similarity between the marks necessary to support a conclusion of likely confusion declines.” *Maher*, 100 USPQ2d at 1022 (citing *Bose*, 63 USPQ2d at 1305). Our focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression

of marks. *Spoons Rests., Inc. v. Morrison, Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd mem.*, 972 F.2d 1353 (Fed. Cir. 1992); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014). Because the goods at issue are clothing and shoes, the average purchaser is an ordinary consumer.

We find that the marks are similar in their overall connotation and commercial impression. As Nike observes, JUST DO IT and JUST BET IT “differ by only one word, replacing the verb ‘DO’ with the verb ‘BET,’ and both marks have the same structure and format, i.e., JUST \_\_ IT.”<sup>43</sup> They both consist of three syllables; they both take the form of hortatory commands, although they are both nonspecific as to what the IT, the action to be done or thing to be betted on, may be; and they both convey the idea of not thinking or hesitating too much, but instead simply following the command.

Obviously DO and BET are different words that look and sound different and have different meanings, but despite those differences, the overall connotation and commercial impression of the marks is similar because, given the fame of Nike’s JUST DO IT mark, the public may perceive Honest E’s mark as a related command. That is, action and betting are sufficiently related (in fact, action encompasses betting) so that consumers could perceive that both JUST DO IT and JUST BET IT are affiliated with Nike, especially considering that betting is often associated with sports, as are Nike’s goods. “[A] purchaser is less likely to perceive differences from a famous mark.” *B.V.D. Licensing v. Body Action Design*, 846 F.2d 727, 730, 6 USPQ2d

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<sup>43</sup> 19 TTABVUE 26 (Nike’s Brief).

1719, 1722 (Fed. Cir. 1988) (Nies, J., dissenting), and quoted with approval in *Kenner Parker*, 22 USPQ2d at 1456. *See generally, Maher*, 100 USPQ2d at 1022-23 (finding JUST JESU IT confusingly similar to JUST DO IT).

In sum, given the fame of Nike's mark, the identical goods and the similarity of connotation and commercial impression, though less so appearance and sound, we find the marks to be similar for likelihood of confusion purposes. The first *DuPont* factor thus weighs in favor of finding likelihood of confusion.

## **V. Conclusion**

On the basis of the established fame, identical goods and similar marks, we find that Nike has established its claim of likelihood of confusion between its JUST DO IT mark and Honest E's JUST BET IT mark. We do not reach the claim of dilution. *See Multisorb Techs., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013) (“[T]he Board’s determination of registrability does not require, in every instance, decision on every pleaded claim”).

**Decision:** The opposition is sustained and registration to Applicant, Honest E, is refused.